

REMARKS/ARGUMENTS

Status of the Claims

Upon entry of the present response, claims 9-18, 25-34 and 41-50 are pending. Claims 19-24 and 35-40 are canceled without disclaimer or prejudice to renewal. Claims 9-10, 14-18, 25-26 and 30-34 are under examination. Claims 11-13, 27-29 and 41-50 are withdrawn as directed to non-elected inventions. No new matter is added by the present amendments, and the Examiner is respectfully requested to enter them.

Request for Rejoinder

For the reasons discussed below, Applicants believe that claims 9-10, 14-18, 25-26 and 30-34 are allowable. Applicants respectfully request rejoinder and examination of claims 11-13, 27-29 and 41-50.

Rejection under 35 U.S.C. § 102(e)

The Examiner has rejected claims 9-10, 14-18, 25-26 and 30-34 under 35 U.S.C. 102(e) as allegedly anticipated by U.S. Patent Publication No. 2005/0026844. This rejection is respectfully traversed.

The reference cited by the Action is not a proper anticipatory reference against the claims under examination. U.S. Appl. No. 10/817,334 ("the '334 application," published as U.S. Patent Publication No. 2005/0026844) was filed on April 2, 2004, which is later than the March 31, 2004 filing date of the present application. The '334 application claims priority to U.S. Provisional Appl. No. 60/460,559 ("the '559 application), filed on April 3, 2003. Therefore, for the purposes of the present rejection, the disclosure in the '559 application, rather than the '334 application, is relevant.

The '559 application does not disclose or suggest inhibiting the progression of obstructive pulmonary disease (including chronic obstructive pulmonary disease ("COPD"), emphysema, and chronic bronchitis), an interstitial lung disease (including idiopathic pulmonary fibrosis) or asthma by administering an inhibitor of sEH, alone or in combination with an EET.

Instead, the '559 application discloses methods of reducing renal deterioration; renal, hepatic, or pulmonary hypertension; adult respiratory distress syndrome, diabetic complications, end stage renal disease, Raynaud syndrome and arthritis by administering an inhibitor of sEH. *See, e.g.*, page 4, lines 19-20; page 17, lines 19-22; and claims 11 and 13 of the '559 application. Renal deterioration; renal, hepatic, or pulmonary hypertension; adult respiratory distress syndrome, diabetic complications, end stage renal disease, Raynaud syndrome and arthritis are not the same disease conditions as obstructive pulmonary disease (including chronic obstructive pulmonary disease ("COPD"), emphysema, and chronic bronchitis), an interstitial lung disease (including idiopathic pulmonary fibrosis) or asthma, and the present Office Action does not allege a connection between the two diseases. The '334 application is not prior art, and the present Office Action fails to show that the '559 application discloses or suggests each and every element of the claims under examination. Accordingly, the Action has failed to present a proper *prima facie* case of anticipation.

Because neither the '334 application nor the '559 application anticipate the present invention, the Examiner is respectfully requested to withdraw this rejection.

Provisional Obviousness-Type Double Patenting

U.S. Appl. No. 11/685,674

The Examiner has rejected claims 9-10, 14-18, 25-26 and 30-34 under the judicially created doctrine of obviousness-type double patenting over claims 111-112, 115, and 120-122 of U.S. Application No. 11/685,674. This is a *provisional* double patenting rejection. Pursuant to M.P.E.P. § 804(I)(B), the Examiner should allege a double patenting rejection in the later pending patent application. Therefore, Applicants defer responding to this rejection until there is an indication of allowable subject matter.

U.S. Appl. No. 11/566,171

The Examiner has rejected claims 9-10, 14-18, 25-26 and 30-34 under the judicially created doctrine of obviousness-type double patenting over claims 1, 10-11 and 20 of U.S. Application No. 11/566,171. This is a *provisional* double patenting rejection. Pursuant to M.P.E.P. § 804(I)(B), the Examiner should allege a double patenting rejection in the later pending patent application. Therefore, Applicants defer responding to this rejection until there is an indication of allowable subject matter.

U.S. Appl. No. 11/240,444

The Examiner has rejected claims 9-10, 14-18, 25-26 and 30-34 under the judicially created doctrine of obviousness-type double patenting over claims 1, 10-11 and 20 of U.S. Application No. 11/240,444. This application is now abandoned. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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Attachments
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